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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/500,683

Filing Date: July 02, 2004

Appellant(s): VAN DOORN, MARKUS GERARDUS

Dan Piotrowski
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 09/24/08 appealing from the Office action mailed 10/17/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest in contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is partly correct.

New ground of rejection has been rendered with respect to claim 6 under 35 USC § 112, *second paragraph*.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6868292

Ficco et al

06-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 112

Claims 5-6 are rejected under 35 USC § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites the following means (or step) plus function limitation: Means for retrieving user profile information based on the user identification.

This limitation invokes 35 USC § 112, ¶ 6 because it meets the 3-prong analysis set forth in MPEP 2181 as it recites the phrase "means for" or "step for" (or appellant identifies the limitation as a means (or step) plus function limitation in the appeal brief) and the phrase is modified by functional language and it is not modified by sufficient structure, material, or acts for performing the recited function. Also see *Altiris Inc. v. Semantec Corp.*, 318 F.3d 1363, 1375 (Fed. Cir. 2003). 35 USC § 112, ¶ 6, requires such claim to be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. "If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section § 112." *In re Donaldson Co.*, 16 F.3d 1189,

Art Unit: 2424

1195, 29 USPQ 1845, 1850 (Fed. Cir. 1994)(in banc.). For a computer-implemented means-plus-function claim limitation that invokes 35 USC § 112, ¶ 6, the corresponding structure is required to be more than simply a general purpose computer. *Aristocrat Technologies, Inc. v. International Game Technology*, 521 F.3d 1328, 1333, 86 USPQ2d 1235, 1239-40 (Fed. Cir. 2008). The corresponding structure for a computer-implemented function must include the algorithm as well as the general purpose computer. *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999). The written description must at least disclose the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the claimed function. *Aristocrat*, 521 F.3d at 1338, 86 USPQ2d at 1242.

In the instant application, the following portions of the specification and drawings may appear to describe the corresponding structure for performing the claimed function: The specification on page 5 paragraph (0050) teaches how the server may retrieve identification of a user.

However, the specification and drawings do not disclose sufficient corresponding structure, material or acts for performing the claimed function. The Specification and claims 5 and 6 indicate that the server retrieves information in the form hand-carried application device such as web tablet. However, the Specification does not set forth any structures (e.g., circuits or components) or processors with software instructions or algorithms, which are to be added to application devices so as to allow them to interact with the server to enable document retrieval by the server from the application devices. As such, Appellant has failed to adequately describe sufficient structure for performing the function claimed.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-19 are rejected under 35 U.S.C. 102(e) as being unpatentable by Ficco et al (US Patent 6,868,292 B2). Hereinafter referred as Ficco.

Regarding claims 1, 5, 7, and 12, Ficco discloses a method, system and computer program of controlling application devices comprising (**Figure 1**): retrieving

first documents (**HTML File (801) in figure 9**) from a first set of application devices by a server (**Host Processor (815) in figure 9**); retrieving identification of a user by the server (**column 16 lines 4-6**); characterized in that the method further comprises the steps of: autonomously generating second documents by the server, each comprising at least one instruction, on the basis of at least a part of the retrieved identification of the user and at least a part of the first documents (**column 16 lines 1-4**); sending at least one of the second documents to each device of a second set of the application devices by the server (**column 16 lines 14-26 shows data is sent and col.16, lines 62-67 shows they are scripts which are considered documents**); and performing, for a given device of the second set, one instruction from at least one of the second documents received in the given device (**HP 310 issues commands (S15) in figure 13**).

Regarding claims 2, 6, 8, and 13, Ficco discloses a method, system and a computer program (**Column 20 lines 8-11**) according to claim 1, characterized in that the step of retrieving identification of the user further comprises the steps of retrieving user profile information based on the user identification by the server (**Column 16 lines 4-6**); and retrieving context profile information relating to surroundings of the user by the server (**Column 16 lines 6-13**).

Regarding claims 3, 9, 14, and 17, Ficco discloses a method according to claim 1, characterized in that the documents comprise at least one of Hyper Text Markup Language (**Column 8 lines 5-6**), Scalable Vector Graphics, Resource Description Framework and Extensible Markup Language (**column 8 lines 14-16**).

Regarding claims 4, 10-11, 15-16, and 18-19, Ficco discloses a method according to claim 1, characterized in that the application devices comprise at least one of Web tablet, set-top box, VCR, TV, PDA, lamp, coffee machine, radio, telephone, background wall, DVD player and electronic information panel (**Figure 1**).

(10) Response to Argument

Appellant argues on page 7 third paragraph of the brief that, "Ficco fails to teach generating second documents on the basis of at least a part of the retrieved identification of the user and at least a part of first documents and sending at least one of the second documents to each device of a second set of the application devices by the server." While appellants point is understood examiner disagrees. Ficco discloses in (column 18 lines 15-28) a user subscribing to a service provider by an NSP. This shows a system must be able to identify a user to be able to retrieve information. In addition, (column 18 lines 32-39) the user would query the NSP to display a suitable web page or screen in which the user may input preferences and/or select desired scripts. This may be affected by the well-known shopping cart model, where the user selects scripts to be temporarily buffered until ready to "check-out." This also shows how a user is identified as in the shopping cart model. It should also be noted that appellant's disclosed documents are HTML or web pages (page 1 of spec). Clearly web pages and scripts meet the limitation of documents.

Appellant also argues on page 8 fifth paragraph, "Ficco fails to teach generating second documents on the basis of at least a part of a retrieved identification of the

user.” Examiner again respectfully disagrees. While appellant’s point is understood, it must be considered that the same paragraph cited (column 16 lines 62-67) continues to (column 17 lines 1-2). This last section mentions a customer is able to select and pay for a particular “pay-per-script” event. This shows that a selective script is retrieved from a user’s choice. Therefore, appellant’s argument is not persuasive since scripts are collections of text which are connected. There is nothing in the term document that precludes the script from being a document.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner’s answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR

41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Franklin Andramuno/

Examiner, Art Unit 2424

Conferees:

/Christopher Kelley/

Supervisory Patent Examiner, Art Unit 2424

/Annan Q. Shang/

Primary Examiner, Art Unit 2424

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Timothy P Callahan/

Director, Technology Center 2400